

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-78 are pending in this application. No claim amendments are presented, thus, no new matter is added.

In the outstanding Office Action, Claims 42-61, 64, 65, and 67-75 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; and Claims 1-41, 62, 63, and 66 were allowed.

Applicants thank the Examiner for the indication of allowable subject matter.

Applicants thank the Examiner for the courtesy of an interview extended to Applicants' representative on November 18, 2008. During the interview, the outstanding rejections under 35 U.S.C. § 112, second paragraph, were discussed. In addition, the Examiner indicated that the Applicants' arguments appear to overcome the outstanding rejections. The arguments presented during the interview are presented below for formal consideration.

Applicants note that Claims 76-78 were not specifically addressed in the body of the Office Action, even though they were indicated as rejected on the front cover of the Office Action. Therefore, it is not clear if Claims 76-78 stand rejected, and if they are rejection then their basis of rejection has not been specified in the Office Action.

With respect to the rejection of Claims 42-61, 64, 65, and 67-75 under 35 U.S.C. § 112, second paragraph, Applicants respectfully traverse this ground of rejection. Claim 42 recites, *inter alia*,

producing license information using at least
identification information of said recording medium.

The Office Action takes the position that "it is understood that the claim limitations create and/or produce license information, *however what appears to be missing from the*

limitation of the claims is clarity involving the type of identification information that is used to produce the license information.” (See Office Action, at page 2). Therefore, it appears that the Office Action is stating that the claim is indefinite because it does not state specifically what type of “identification information of said recording medium” is being used.

However, MPEP §2173.04 (“Breadth Is Not Indefiniteness”) states the following:

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention as evidenced by statements outside of the application as filed, a rejection under 35 U.S.C. 112, second paragraph, would be appropriate. If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under 35 U.S.C. 112, first paragraph, would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.

In this case, Applicants submit that the type of identification information recited in Claim 42 is a matter of the breadth of the claim and is not a matter of indefiniteness under 35 U.S.C. §112, second paragraph. Applicants submit that the phrase “identification information of said recording medium” is a clear and definite phrase as recited in the claim and the examiner appears to have only stated that the phrase is currently too broad, which is not a sole basis for indefiniteness according to the MPEP.

The Office Action also states “*after the ‘identification information’ is used, then what happens to the processing of the ‘identification information.’*” (See Office Action, at page 2). It appears as if the Office Action is posing a question and stating that the claim is also indefinite because it does not recite additional processing of the identification information after it is used to produce the license information. It is not clear what the Office

Action is regarding as a point of indefiniteness here. Applicants submit that there is nothing unclear or indefinite about the claim if the identification information is not recited as being further processed after it is used to produce the license information. Again, it appears that the examiner is requiring more specificity in the claim than is required under 35 U.S.C. §112, second paragraph. However, Applicants reiterate that matters regarding the breadth of the claim cannot be a sole basis for indefiniteness according to the MPEP, as noted above.

The Office Action further states that “*the specification only recites ‘using identification information.’ There are no details provided in the specification that would provide clarity on the descriptive functionality of the type of ‘identification information’ mentioned in the claims.*” (See Office Action, at page 3). Applicants respectfully disagree. In a non-limiting example, the specification describes that a recording medium is a secure digital (SD) card and identification information is a serial ID of the SD card (see specification, at page 37, lines 11-15).

Therefore, Applicants respectfully submit that the use of the phrase “identification information of said recording medium” is clear and definite in Claim 42 according to its well-known meaning in the art and in light of the specification. Therefore, Applicants respectfully request that this ground of rejection be withdrawn.

Independent Claims 60, 61, 64, 65, 67, 68, 69, 70, 71, and 72 recite features similar to those of Claim 42 discussed above. Therefore, Applicants respectfully request that the rejection of Claims 60, 61, 64, 65, 67, 68, 69, 70, 71, and 72 (and all associated dependent Claims) under 35 U.S.C. §112, second paragraph, be withdrawn for similar reasons as discussed above.

Applicants note that Claim 54 does not recite the phrase “identification information.” Therefore, it is not clear why Claim 54 (and all associated dependent claims) were rejected under 35 U.S.C. §112, second paragraph. Therefore, it is respectfully requested that the

ground of rejection with respect to Claim 54 (and all associated dependent claims) be withdrawn

Furthermore, allowed Claims 62, 63, and 66 each recite “*using at least identification information of said recording medium.*” However, none of these claims were rejected under 35 U.S.C. §112, second paragraph, even though they recite similar language as the language of Claim 42 which was deemed indefinite. Therefore, Applicants submit that because allowed Claims 62, 63, and 66 were considered clear and definite by the examiner, then Claims 42-61, 64, 65, and 67-75 should also be considered clear and definite.

Applicants further submit that due to the above-mentioned inconsistencies and discrepancies in the in the Office Action with regard to independent claims 76-78, Claim 54, and allowed Claims 62, 63, and 66, the next Office Action must be non-final.

Consequently, in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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